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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,829	04/10/2001	Gregory G. Menoveik	IN-5474	1272
26922	7590	10/06/2003	EXAMINER	
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442			RAJGURU, UMAKANT K	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,829	MENOVCIK ET AL.	
	Examiner	Art Unit	
	Umakant K. Rajguru	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to a composition, classified in class 524, subclass 364.
 - II. Claims 24-26, drawn to a method of reducing volatile organic content, classified in class 524, subclass 800+.
 - III. Claims 27-30, drawn to a process for coating, classified in class 427, subclass 319.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as roller-coating, dip-coating etc.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as a solution of a polymer.

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Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Attorney Anne Gerry Sabourin on May 5, 2003 a provisional election was made with traverse to prosecute the invention of I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is vague in reciting, "to form a colloidal emulsion of water" in lines 6-7 since there is no water in the scope of this claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6, 13, 14, 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohrbom et al (US 6,160,058) in view of Yokoyama et al (US 2001/0036999).

Ohrbom discloses curable coating compositions comprising component (a), component (b) and component (c) (abstract ; column 3, lines 3-5). Component (b) is

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an acrylic polymer with hydroxyl functionality (column 11, lines 60-65). Carbamate functionality may also be introduced to acrylic polymer (column 12, lines 30-31). A solvent may be used in the composition one of them being methyl ethyl ketone, which reads on component (c) of instant claim 1 (column 16, lines 6-10). Water is also used.

Ohrbom does not specifically teach a water-miscible organic solvent (of instant claim 1).

Yokoyama describes low volatile organic content coating compositions based on (a) polyester-based polyol resin and (2) acrylic polyol resin. Few solvents such as acetone are also used (page 3, paragraph 0022).

It would therefore have been obvious to add the composition of Ohrbom, the solvent (of Yokoyama) in order to lower the viscosity and facilitate application of composition by spraying.

It is noted that prior art does not specifically suggest the colloidal emulsification of water. This limitation of instant claim 5 can be assumed to be inherently satisfied by prior art because when the coating composition is prepared by thorough mixing of all ingredients (including water), water which is a discontinuous phase is likely to be emulsified in the continuous polymeric phase.

6. Claims 7, 8, 9, 10, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohrbom et al (US 6,160,058) in view of Yokoyama et al (US 2001/0036999) as applied to claim 1 above, and further in view of Grandhee (US 6,342,558).

Ohrbom and Yokoyama together fail to mention the claimed hydroxyl equivalent.

Grandhee discloses a primer containing acrylic polymer with an equivalent wt of 1000 or less per equivalent. (column 4, lines 66-67).

It would therefore have been obvious to use acrylic polymer having equivalent weight (as taught by Grandhee) in order to enhance chip resistance of film.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohrbom et al (US 6,160,058) in view of Yokoyama et al (US 2001/0036999) as applied to claims 1 and 6 above, and further in view of Ohrbom et al (US 2003/0114590).

Ohrbom '058 and Yokoyama together fail to mention the claimed carbamate equivalent.

Ohrbom '590 discloses in [0039] an acrylic polymer with a carbonate equivalent wt of 250 to 1500 g/mole.

Hence it would have been obvious to use in the composition of Ohrbom '058, an acrylic polymer having a carbamate equivalent wt. (as taught by Ohrbom '590) to make the film more etch resistant and also more flexible.

8. Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone

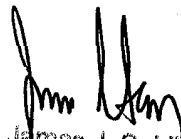
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numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.



U.K. Rajguru/dh
September 25, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700